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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SAFAVI, MICHAEL

ART UNIT PAPER NUMBER

3673

DATE MAILED: 02/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/814,066

Applicant(s)

KNAUSEDER, FRANZ

Examiner

M. Safavi

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 14-16, 21-24, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austrian reference 405,560 in view of German reference 29703962 when considering any of Scarlett, Keller et al., and Turner.

Austrian reference '560 discloses the configuration of attaching flat structural cladding or substrate components as recited in claims 1-20 of the instant application. Austrian '560 does not appear to disclose any specific use of adhesive with the attaching configuration. However, German reference 29703962 teaches utilization of a contact adhesive between tongue and groove joints so as to establish a secure engagement between cladding panels of a substrate. And, each of Scarlett, Keller et al., and Turner teach application of an adhesive upon or within a locking joint between structural members with Scarlett, for example, teaching a desire to establish a self-locking assembly to achieve a joint which does not require independent clamping or other retention means during curing of the glue or adhesive, col. 3, lines 45-48 of Scarlett. See, also, col. 2, lines 24-39 of Scarlett. To have provided the floor tile assembly of Austrian '560 with adhesive between and within the tongue and groove joints between the panels 1,

2, including any particular adhesive, thus securely fastening adjacent floor tiles one to another while realizing any and all advantages of adhesives within a self-locking joint, would have constituted an obvious expedient to one of ordinary skill in the art as taught by German reference 29703962 when considering any of Scarlett, Keller et al., and Turner.

3. Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austrian reference 405,560 in view of German reference 29703962 when considering any of Scarlett, Keller et al., and Turner as applied to claims 1, 2, 14-16, 21-24, and 31 above, and further in view of Roesch et al.

Roesch et al., for example, teach utilization and advantages of various "two component" adhesives including microencapsulatable solvent adhesives that contain polymer resin and appropriate solvents as well as polyvinyl acetate base, methyl acrylate base, epoxide base etc.

To have provided the modified floor tile assembly of Austrian '560 with a two component adhesive, (including adhesive with activating substance, microencapsulated adhesive, etc.), between and within the tongue and groove joints between the panels 1, 2, thus securely fastening adjacent floor tiles one to another while realizing any and all advantages of such well known adhesives and particularly "two component adhesives", would have constituted an obvious expedient to one of ordinary skill in the art as taught by Roesch et al.

Response to Arguments

Applicant's arguments filed December 08, 2003 have been fully considered but they are not persuasive. Applicant's arguments with respect to "glue is not preapplied" appear directed to process when the rejected claims define an article of manufacture. The panel assembly of Australian '560, as modified, serves to read upon the article defined by the respectively rejected claims. Applicant argues "glue is not preapplied" however, the panel assembly of Australian '560, as modified in the above proposed rejections, can be formed as by pre-applying any adhesive and thus serve to read upon the language of the rejected claims with the term "preapplied" merely defining a process of manufacture. The product of Australian '560, as modified, and, the final product of the instant invention, (i.e., structural components with a glued interlocking tongue and groove joint), being one and the same. Otherwise, the patentability of a claim to a product does not depend on merely a difference in its method of production, but on whether the product itself is new and unobvious. In re Pilkington, 411 F.2d 348, 192 U.S.P.Q. 145, 147 (CCPA 1969). If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the product was made by a different process. In re Fessman, 489 F.2d 742, 180 U.S.P.Q. 324 (CCPA 1974) and In re Thorpe, 777 F.2d 695, 227 U.S.P.Q. 964 (Fed. Cir. 1985). When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to

present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. In re Brown, 450 F.2d 531, 173 U.S.P.Q. 685 (CCPA This burden is NOT discharged solely because the product was derived from a process not known in the prior art. In re Fessman, supra.

It is, otherwise, not seen how "in using the glue of Scarlett in the application of the Australian reference, an excessive quantity of glue may result...". Each of Scarlett, Keller et al., and Turner are utilized to teach gluing an interlocking tongue and groove joint. Applicant has failed to establish how the claimed product differs in kind from that of the modified Australian '560 assembly.

In response to applicant's argument that "one of ordinary skill in the art did not even recognize the problem which is solved by the present invention", the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

As for Applicant's argument to Roesch et al. being of non-analogous art, one having ordinary skill in the art would certainly turn to the Roesch et al. teaching of an adhesive attachment of pipes, fittings, and connectors when determining what specific adhesives could be used in the assembly of inter-fitting structural elements.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (703) 308-2168.



**MICHAEL SAFAVI
PRIMARY EXAMINER
ART UNIT 354**

M. Safavi
February 18, 2004